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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,026	06/30/2003	Alan M. Zamore	2003-5	7377
23401	7590	03/14/2006	EXAMINER	
ALAN M ZAMORE 23 MOUNTAIN AVE MONSEY, NY 10952			SERGENT, RABON A	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/608,026	<b>Applicant(s)</b> ZAMORE, ALAN M.	
	<b>Examiner</b> Rabon Sergeant	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-24 and 26-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The terminal disclaimer filed on September 13, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 6,596,818 has been reviewed and is accepted. The terminal disclaimer has been recorded.
2. Claims 23, 24, and 26-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, with respect to component (b) of claims 23 and 24, the species should not be recited in the alternative. In other words, “or” should not be present between “trialylisocyanurate (“TAIC”)” and “trialylcyanurate (“TAC”))”. This issue was set forth in the previous Office action on the merits.

Secondly, with respect to claims 26-31, applicants have amended the claims to recite that the composition is free of aromatic carbonyl compounds; however, the claims specifically recite component species that contain aromatic carbonyl groups. For example, the claimed terephthalate based compositions contain aromatic carbonyl groups. Therefore, applicant’s claims are confusing and ambiguous, because it cannot be determined exactly compounds are to be excluded from the compositions.

Lastly, with respect to claims 32 and 33, in view of applicant’s amendment, it is questioned if the language, “cross-linkable composition”, within line 2 of claim 32 should be “crosslinked composition”. As currently drafted, the claim essentially specifies that a cross-linkable composition is produced by irradiating a cross-linkable composition. This recitation does not appear to agree with the crux of the invention or the rest of claim 32.

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3. Claims 26-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Within the claims 26 and 29, the amendment specifying that the composition is free of aromatic carbonyl compounds constitutes new matter, because support has not been found within the specification for the claimed exclusion of such compounds.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 12-24 and 26-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of copending Application No. 10/688,292. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims drawn to an angioplasty balloon or composition or article, each comprising a crosslinked or crosslinkable copoly(ether-ester-amide) are obvious variants of the catheter balloon comprising radiation crosslinked polyamide/polyether polyester of claim 24 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 26, 28, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. ('316).

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Patentees disclose a photosensitive resin composition comprising a thermoplastic elastomer, such as a polyamide-imide ester derived from a polyoxyalkylene glycol, and an unsaturated compound, such as an acrylate, methacrylate, or allylic compound. See abstract; column 2, lines 40+; column 3, lines 16+; and column 8, lines 41-57. The position is taken that patentees' thermoplastic elastomer meets applicant's copoly(ether-ester-amide) polymer and that the disclosure at column 13, lines 10+ is sufficient to satisfy the requirements of claims 28 and 31. Furthermore, applicant's claimed increased tolerances are inherent features of the disclosed compositions.

8. Applicant has argued that the amendment specifying that the composition is free of aromatic carbonyl compounds distinguishes the claims from Suzuki et al. The examiner has considered this argument; however, it is insufficient to remove the prior art rejection. Suzuki et al. does not mandate the use of the disclosed carbonyl compounds, as patentees clearly recite that various known photopolymerization initiators can be used, of which carbonyl compounds are simply preferred. Accordingly, the position is taken that patentees' disclosure encompasses photoinitiators in addition to only carbonyl compounds.

9. Claims 23, 24, and 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil et al. ('551 or '415).

Patentees disclose the conversion of a thermoplastic copoly(ether-ester-amide) to a thermoset or crosslinked product by incorporating triallylcyanurate or triallylisocyanurate into the thermoplastic and subsequently exposing the resulting composition to irradiation. See abstract and columns 3 and 4. Patentees further disclose that the compositions may be used in the medical field or as insulation in the wire and cable industry. See column 4, lines 49+. The

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position is taken that applicant's claimed increased tolerances are inherent features of the composition and that the disclosed medical applications inherently encompass sterilization procedures or features.

10. The examiner has considered applicant's arguments, however, the prior art rejection has been maintained for the following reasons. With respect to claims 23 and 24, to the extent claimed, it is not seen that the claimed devices distinguish the claims from the prior art. Without further definition and/or limitation with respect to the claimed devices, the position is taken that the disclosed devices and applications of the prior art inherently function in capacities analogous to the functions of the devices of the claims. For example, the use of the prior art composition as wire insulation satisfies all requirements associated with applicant's claimed "seals".

Furthermore, applicant has not established that the prior art compositions will not inherently function in heat shrinkable applications. One would reasonably expect the disclosed compositions to have this capability, since the disclosed compositions and claimed compositions are produced from the same components. With respect to claims 26-31, applicant's argument is insufficient to remove the prior art rejection. Applicant has argued that O'Neil et al. teach away from the present invention, because patentees note that degradation may occur at high radiation levels. This argument is not found persuasive, because, contrary to applicant's assertion, applicant has not established that his composition is not subject to the same type of behavior noted by patentees. Furthermore, it must be stressed that patentees do not suggest that their composition degrades to the point of being useless or unsuitable for the disclosed applications. Lastly, it noted that applicant's claims are not quantitatively limited with respect to the degree of tolerance obtained or the amount of radiation applied; therefore, it cannot be argued that

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applicant's claims encompass levels of radiation that exceed patentees' "too high" or degradation producing levels of radiation.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
March 9, 2006

  
**RABON SERGENT**  
**PRIMARY EXAMINER**